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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/551,303
Filing Date: April 18, 2000
Appellant(s): KING ET AL.

MAILED
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Technology Center 2100

Kevin G. Shao (Reg. No. 45,095)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11-16-2007 appealing from the Office
action mailed 2-23-2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 8-13, 15, 16, 18-24, 26, and 32-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,392,671 B1 (Glaser).

7. Referring to claims 1, 10, 16, 19, 32, 41, 47, 50, and 58, Glaser discloses in column 5: lines 27-67 a digital processing system that retrieves a data value representing an appearance of an enclosure of said digital processing system. It is noted that the examiner interprets a digital processing system to include the processing unit, the display, and the peripherals connected to the processing unit. Furthermore, "an appearance of an enclosure of said digital processing system", is interpreted in view of Glaser as an appearance of an enclosure of a mouse or other peripheral that is a part of the digital processing system. Glaser further notes that the mouse may contain computer memory and a microprocessor to implement the Glaser system (see column 8, lines 20-28). Glaser further discloses in column 5: lines 63-67 that in one embodiment, the color of the computer peripheral is coordinated with a desktop theme

of the digital processing system. In such an embodiment, the color of the enclosure of the computer peripheral must be represented by the data value, and the appearance of the display of the digital processing system is thus determined according to the appearance of the enclosure of the peripheral. In an alternate embodiment, the user further has the ability to set store a set of user preferences (customize the stored theme) in the digital processing system, which, if customized, is used to control features of the operating system (see column 2, lines 14-18). An example of this dynamic configuration is disclosed in Glaser, in column 6, lines 1-11, where he teaches an application program including a given animated cartoon character is executed upon connection of a mouse having a similar animated cartoon character appearance. Figure 1, of Glaser, "depicts a computer system to which the present invention is applicable" (see column 4, lines 37 and 38), the computer system encompasses a mouse enclosure [4]. Here the computer system as a whole is a digital processing system, and the mouse [4] encompasses a portion of this digital processing system, it is an enclosure of the system.

Glaser doesn't specifically teach that the enclosure the GUI is modeled after is that of the enclosure of the systems as a whole, however, it would have been obvious to one of ordinary skill in the art, having the teachings of Glaser before him at the time the invention was made to modify the system based on any (or all) enclosure(s) connected to the system (monitor, tower, peripheral, etc.). One would have been motivated to make such a combination because the mouse, as described in Glaser, is an enclosure

of the system, a portion of the system that can contain the processing and memory of the system (see column 8, lines 20-27).

8. Referring to claims 2, 20, 33, and 51, Glaser discloses in column 5: lines 27-30 that the data value is stored in a memory, which is coupled to the digital processing system.

9. Referring to claims 3, 34, and 52, Glaser discloses in column 5: lines 27-67 a digital processing system that retrieves a data value representing an appearance of an enclosure of said digital processing system. It is noted that the examiner interprets a digital processing system to include the processing unit, the display, and the peripherals connected to the processing unit. Furthermore, "an appearance of an enclosure of said digital processing system", is interpreted in view of Glaser as an appearance of an enclosure of a mouse or other peripheral that is a part of the digital processing system. Glaser further discloses in column 5: lines 63-67 that in one embodiment, the color of the computer peripheral is coordinated with a desktop theme of the digital processing system. In such an embodiment, the color of the enclosure of the computer peripheral must be represented by the data value, and the appearance of the display of the digital processing system is thus determined according to the appearance of the enclosure of the peripheral. Glaser still further discloses in column 5: lines 27-30 that the data value is stored in a non-volatile memory, which is coupled to the digital processing system. Glaser explains in column 5: lines 38-43 that the invention is operable when a computer system is turned on for the first time. In such an instance, the value must inherently be stored by a manufacturer of the digital processing system.

10. Referring to claims 4, 35, and 53, Glaser discloses in column 7: lines 43-59 that user-defined display preferences are stored by the digital processing system. Glaser further discloses in column 3: lines 5-13 that conflicts among desktop themes are resolved by the digital processing system. Glaser's system, accordingly, must inherently determine if there are any user-defined display preferences stored in the digital processing system.

11. Referring to claims 5, 36, and 54, Glaser discloses in column 7: lines 43-59 that users can establish a display preference for disabling automatic theme changing. When automatic theme changing is disabled, the system will determine that user-defined display preferences are stored prior to retrieving the data value.

12. Referring to claims 6, 37, and 55, Glaser explains in column 5: lines 38-43 that the invention is operable when a computer system is turned on for the first time. In such a case, no user-defined display preferences will have been stored and the data value will be retrieved as explained above.

13. Referring to claims 8, 39, and 57, Glaser discloses in claim 12 that determining the appearance of the display comprises setting an appearance of: background color, cursor shape, wallpaper design, icon shape, sounds, button shape, and control bar color.

14. Referring to claims 9, 21, 27-31, and 40, Glaser sufficiently discloses the limitations of the instant claims as discussed above with reference to claims 1-6 and 8.

15. Referring to claims 11, and 42, Glaser discloses in column 5: lines 27-30 that the data value is stored in a non-volatile memory, which is coupled to the digital processing system.

16. Referring to claims 12, 22, and 43, Glaser discloses in column 7: lines 43-59 that user-defined display preferences are stored by the digital processing system. Glaser further discloses in column 3: lines 5-13 that conflicts among desktop themes are resolved by the digital processing system. Glaser's system, accordingly, must inherently determine if there are any user-defined display preferences stored in the digital processing system.

17. Referring to claims 13 and 44, Glaser discloses in column 7: lines 43-59 that users can establish a display preference for disabling automatic theme changing. The processor will thus set the appearance of the display based on this preference.

18. Referring to claims 15, 18, 26, 46, and 49, Glaser discloses in claim 12 that determining the appearance of the display comprises setting an appearance of: background color, cursor shape, wallpaper design, icon shape, sounds, button shape, and control bar color.

19. Referring to claim 23, Glaser discloses in column 7: lines 43-59 that users can establish a display preference for disabling automatic theme changing. When automatic theme changing is disabled, the system will determine that user-defined display preferences are stored prior to retrieving the data value.

20. Referring to claim 24, Glaser explains in column 5: lines 38-43 that the invention is operable when a computer system is turned on for the first time. In such a case, no user-defined display preferences will have been stored and the data value will be retrieved as explained above.

21. Referring to claims 38, 45, 48, and 56, Glaser discloses in claim 12 that theme information comprises setting an appearance of: background color, cursor shape, wallpaper design, icon shape, sounds, button shape, and control bar color.

(10) Response to Argument

Claims 1, 10, 19, 32, 41, 50, and 58:

With respect to the arguments directed at the independent claims including Claims 1, 10, 19, 32, 41, 50, and 58 the Appellant's arguments are focused on the limitations regarding whether the appearance of the display is based on the appearance of an enclosure of the system. More specifically, as stated from representative Claim 1, the limitation argued is:

“

*retrieving a data value representing an appearance of an enclosure
enclosing said digital processing system including a
microprocessor, wherein said data value includes a value*

representing at least one of a machine type and a color of said enclosure of said digital processing system; and determining an appearance of a display of said digital processing system based upon said appearance of said enclosure

”

Since the interpretation of the limitation is the basis for the arguments, the Examiner's interpretation is now given. The claim, as interpreted by the examiner, pertains to a system in which data describing the appearance of an enclosure of the system (not necessarily the whole system) is used to affect the display of the system. As stated in the eighth paragraph of MPEP 2101[R2].II.C.,

“Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023,1027-28 (Fed. Cir. 1997).”

Based on the interpretation of the claim limitations being argued, the Examiner will now explain how the teachings of the Glasser reference are within the scope of these limitations.

Glaser discloses in column 5: lines 27-67 a digital processing system that retrieves a data value representing an appearance of an enclosure of said digital processing system. It is noted that the examiner interprets a digital processing system

to include the processing unit, the display, and the peripherals connected to the processing unit. Furthermore, "an appearance of an enclosure of said digital processing system", is interpreted in view of Glaser as an appearance of an enclosure of a mouse or other peripheral that is a part of the digital processing system. Glaser further notes that the mouse may contain computer memory and a microprocessor to implement the Glaser system (see column 8, lines 20-28). Glaser further discloses in column 5: lines 63-67 that in one embodiment, the color of the computer peripheral is coordinated with a desktop theme of the digital processing system. In such an embodiment, the color of the enclosure of the computer peripheral must be represented by the data value, and the appearance of the display of the digital processing system is thus determined according to the appearance of the enclosure of the peripheral. In an alternate embodiment, the user further has the ability to set store a set of user preferences (customize the stored theme) in the digital processing system, which, if customized, is used to control features of the operating system (see column 2, lines 14-18). An example of this dynamic configuration is disclosed in Glaser, in column 6, lines 1-11, where he teaches an application program including a given animated cartoon character is executed upon connection of a mouse having a similar animated cartoon character appearance. Figure 1, of Glaser, "depicts a computer system to which the present invention is applicable" (see column 4, lines 37 and 38), the computer system encompasses a mouse enclosure [4]. Here the computer system as a whole is a digital processing system, and the mouse [4] encompasses a portion of this digital processing system, it is an enclosure of the system.

Glaser doesn't specifically teach that the enclosure the GUI is modeled after is that of the enclosure of the systems as a whole, however, it would have been obvious to one of ordinary skill in the art, having the teachings of Glaser before him at the time the invention was made to modify the system based on any (or all) enclosure(s) connected to the system (monitor, tower, peripheral, etc.). One would have been motivated to make such a combination because the mouse, as described in Glaser, is an enclosure of the system, a portion of the system that can contain the processing and memory of the system (see column 8, lines 20-27).

The examiner will now address the individual arguments and statements made by Appellant.

From page 7 of the Appeal Brief, from the third paragraph, the Appellant argues that "the desktop scheme of Glaser is not based on an enclosure of the mouse and definitely not based on an enclosure enclosing the computer, including its microprocessor."

The examiner respectfully contends that the claim does not claim an appearance of an enclosure enclosing a microprocessor, but rather "an appearance of an enclosure enclosing a digital processing system including a microprocessor", this is believed to be a very important distinction. Figure 1, of Glaser, "depicts a computer system to which the present invention is applicable" (see column 4, lines 37 and 38), the computer system encompasses a mouse enclosure [4]. Using the claim language the examiners

interpretation will now be given, "an appearance of an enclosure (one enclosure among possibly many, specifically mouse [14]) enclosing said digital processing system" (of the computer systems including enclosures microprocessor unit [1], keyboard [2], monitor [3], and mouse [4]). Here the computer system as a whole is a digital processing system, and the mouse [4] encompasses a portion of this digital processing system, it is an enclosure of the system.

Furthermore, the mouse (an enclosure) as is defined by Glaser is a part of the computer and may contain a computer memory and a microprocessor for implementing the Glaser system (see column 8, lines 20-28). This mouse having a theme such as shape, color, motif, graphic, this is coordinated with a desktop theme or the graphical user interface of the computer system (see column 5, lines 63-67). Glaser teaches, in column 6, lines 1-11, an application program displaying a theme of a given animated cartoon character because of the connection of a mouse having a similar animated cartoon character appearance. This mouse is defined to have an outer appearance, and data stored within describing the outer appearance, where this data is provided to the display to modify the desktop scheme.

From page 8 of the Appeal Brief, from the second paragraph, the Appellant argues that if the mouse is interpreted to have a memory and microprocessor, as in the disclosed embodiment of Glaser the system would have two separate units, which is not what is claimed by the applicant.

The examiner respectfully contends that Glaser's teaching of column 8, lines 20-35, teaches an entire computer (memory and processor) being loaded on a single semiconductor substrate, where such computers are able to be mounted in a mouse in accordance with the present invention. Given this embodiment Glaser teaches a single system including a mouse with an embedded computer that controls a display of the system in accordance with outer appearance of the computer system (mouse enclosure).

Claims 2-3, 11, 20-21, 33-34, 42-43, and 52-52:

From page 9 of the Appeal Brief, from the fourth paragraph, the Appellant argues that "independent claim 2, includes that the data value is stored in a memory which is coupled to the digital processing system. It is respectfully submitted that these limitations are absent from Glaser."

The Examiner first, submits that claim 2 is a dependent claim. The examiner respectfully contends that Glaser teaches, in column 5, lines 27-30 and column 8, lines 20-35, the system receives and identification of the unique mouse motif from the memory of the unique mouse.

From page 10 of the Appeal Brief, from the second paragraph, the Appellant argues that "such a data value is not used to represent an enclosure of

a digital processing system." "At most, such a data value can only be used to represent a specific design of the mouse."

The examiner respectfully contends that the enclosure of a mouse is an enclosure of the digital processing system, possibly not the whole system, but an enclosure of at least a portion of it. Glaser further teaches, in column 8, lines 20-35, an entire computer (memory and processor) being loaded on a mouse in accordance with the present invention. Given this embodiment Glaser teaches a single system including a mouse with an embedded computer that controls a display of the system in accordance with outer appearance of the computer system (mouse enclosure).

Claims 4-6, 12-13, 22-24, 35-38, 40, 44-45, and 53-56:

From page 11 of the Appeal Brief, from the second paragraph, the Appellant argues that Glaser doesn't inherently teach determining "if there are any user-defined display preferences stored in the digital processing system".

The examiner respectfully contends that this conclusion was determined based on Glaser teaching a set of display preferences including: a user's favorite themes, last used theme, most user theme, least used theme, and user preferences (see column 7, lines 44-56).

Claims 8, 15, 26, 39, 46, and 57:

Applicants only argue that these claims are allowable based on their dependence upon an allowable base claim

Claims 16, 18, and 47-49:

From page 12 of the Appeal Brief, from the fourth paragraph, the Appellant argues that "As described above, the identification means of Glaser's mouse does not represent an enclosure of a digital processing system. Thus, Glaser fails to disclose or suggest storing such a data value in a non-volatile memory of the digital processing system."

The examiner respectfully contends that in addition to the above answer, Glaser further teaches, in column 5, lines 26-37, column 8, lines 20-35, and in column 2, lines 14-18, storing in a memory (that does not lose memory when shut down) data regarding an appearance of the enclosure.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Application/Control Number:
09/551,303
Art Unit: 2173

Page 16

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:

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January 30, 2008

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